

REMARKS

Applicant respectfully requests reconsideration of this application. Claim 7 has been amended to correct its dependency and claim 13 has been canceled, without prejudice or disclaimer.

The rejection of claim 7 under § 112 must be withdrawn.

The rejection of claim 7 under § 112 has been fully obviated by way of the amendments made herein to claim 7 and, therefore, the rejection must be withdrawn.

The rejection of claim 8 based on the *Rivera* reference must be withdrawn.

Applicant respectfully traverses the rejection under 35 U.S.C. §102(b) of claim 8 as allegedly being anticipated by the *Rivera* reference. There is no bonding agent that adhesively secures the overlay 116 to the guide rail 106. Even if the snap fit arrangement is considered to “tend to adhere or cause adherence” that does not rise to the level of making it an adhesive bonding agent. There are a variety of ways of causing two things to remain in a desired relative position to each other. A snap fit arrangement as shown in the *Rivera* reference is one approach. A bonding agent that adhesively secures things together is another approach. While both may involve some adherence, the *Rivera* reference has nothing that includes adhesively securing things together. Normal English usage of the terms leads one to the immediate conclusion that a snap fit arrangement as taught by the *Rivera* reference is distinct from and different than an arrangement that includes a bonding agent that adhesively secures things together. There is no sticky or glue-like substance involved in the *Rivera* reference and, therefore, no bonding agent that adhesive secures things together.

There is no *prima facie* case of anticipation and the rejection must be withdrawn.

**The rejection of claims 8 and 10-12 based on the
Mier reference must be withdrawn.**

Applicant respectfully traverses the rejection of claims 8 and 10-12 under 35 U.S.C. §102(b) as allegedly being anticipated by the *Mier* reference. Again, the Examiner is equating a snap-fit arrangement with a bonding agent that adhesively secures two things together. It is not a reasonable interpretation to consider a snap-fit arrangement to be the same thing as an arrangement that includes a bonding agent that adhesively secures two things together. There is nothing corresponding to such a bonding agent in the *Mier* reference and the rejection must be withdrawn.

**The rejection of claim 13 based upon the
Eames reference must be withdrawn.**

To advance prosecution, Applicants have opted to cancel claim 13, without prejudice or disclaimer. Accordingly, this rejection is now moot and must be withdrawn.

**The rejection of claims 1-4, 7-9 and 21
based on the proposed combination of the
Rivera and *Marteness* references must be withdrawn.**

Applicant respectfully traverses the rejection under 35 U.S.C. §103 of claims 1-4, 7-9 and 21 based upon a proposed combination of the *Rivera* and *Marteness* references. As explained above, there is nothing in the *Rivera* reference that supports the Examiner's position that there is a bonding agent adhesively securing materials together. A snap-fit arrangement does not involve a bonding agent that adhesively secures materials together. The *Marteness* reference can not be used to cure this deficiency of the *Rivera* reference because the proposed combination cannot be made.

The *Marteness* reference does not pertain to elevator guide rails and, instead, is concerned with electrically-insulated rail joints for electrical signals. Although the insulated rail

joints of the *Marteness* reference include fish plates or joint bars that are adhesively bonded to the rails, there are no such plates or joint bars in the *Rivera* reference. Moreover, there is no possible reason to include such plates or bars in the *Rivera* reference as guiderails in an elevator system are not used for electrical signals of the type described in the *Marteness* reference. One skilled in the art, therefore, would find no reason whatsoever to combine the teachings of the *Marteness* reference with those of the *Rivera* reference. Without Applicant's disclosure in the first instance, there would have been no possible reason for even suggesting the combination. Such hindsight reasoning cannot be used to attempt to manufacture a *prima facie* case of obviousness. The proposed combination cannot be made.

Additionally, the *Rivera* reference already teaches a snap-fit arrangement that accomplishes the goals stated in that reference. There would be no benefit to adding materials from the *Marteness* reference because they would only be redundant, at best. Where there is no benefit flowing from a proposed combination, it cannot be made and there is no *prima facie* case of obviousness.

The rejection of claims 1-4, 7-9 and 21 must be withdrawn.

**The rejection of claims 1-4, 7-9 and 21
based upon the proposed combination of the
Mier and *Marteness* references must be withdrawn.**

The very same reasons for why the rejection based upon the proposed combination of the *Rivera* and *Marteness* references does not establish a *prima facie* case of obviousness apply to this rejection. The *Marteness* reference is not useful in the context of the *Mier* reference and one skilled in the art would not look to it for any purpose if they were dealing with the *Mier* reference. The electrically insulated joints of the *Marteness* reference have no purpose or use in the context of the *Mier* reference. There would be no benefit to adding the teachings of the

Marteness reference to those of the *Mier* reference. There is no *prima facie* case of obviousness because the combination cannot be made.

All claims should be allowed.

Respectfully submitted,
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